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REMARKS

Claims 1-3 and 5-9 are pending in the present application after this amendment adds new claim 9. Claims 1-3 and 5-8 are amended by this amendment to clarify the subject matter recited therein. No new matter is added by the new claim and the amendments, which find support throughout the specification and figures. In view of the amendments and the following remarks, reconsideration of the present application is respectfully requested.

Claims 1-3 and 5-8 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Claims 1-3 and 5-8 are amended to clarify the subject matter recited therein, highlight the structural elements recited therein, and promote readability by adding additional indentations between features. Therefore, it is respectfully submitted that the claims are definite, and requested that the rejection be withdrawn.

Claims 1-3, 5, 7, and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over "Betting on a quick, decisive battle in the scramble for mileage program members: ANA'S CTI Internet-ready system", Computopia (hereinafter referred to as Computerage), in view of Brower, Helen; "Business Travel-corporate plans; JAL develops bonus program that companies bank on"; Travel-Weekly (hereinafter referred to as Brower), in view of Unexamined Patent No. 119-34962 (hereinafter referred to as the '962 document), in view of Unexamined Patent No. H1 1-353359 (hereinafter referred to as the '359 document). Applicants respectfully traverse.

Claim 1 relates to a system for performing a mileage service depending on a distance traveled by a vehicle. Claim 1 recites, *inter alia*, mileage information storing means adapted to *subtract miles included in said boarding information from accumulated miles of said boarding customer* if said boarding customer is employed by the corporation registered for the corporate mileage service based on said corporation vs. individual relationship information transmitted

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from said corporation vs. individual relationship information database device, and *add the subtracted miles included in said boarding information to miles of the corporation.*

The Examiner admits that Computerage does not disclose the feature of a database storing a corporation and an individual mileage accounts, nor the feature of subtracting miles from a customer account. (Office Action; page 5, lines 4-9). The Examiner asserts that Brower discloses separate identifiers and accounts and that the '962 document discloses storing personal and business information separately. However, the Examiner does not even allege that either of Brower or the '962 document, or any other reference, discloses or suggests the feature of a mileage information storing means that is adapted to *subtract miles included in said boarding information* from accumulated miles of said boarding customer if said boarding customer is employed by the corporation registered for the corporate mileage service based on said corporation vs. individual relationship information transmitted from said corporation vs. individual relationship information database device, and *add the subtracted miles* included in said boarding information to miles of the corporation.

Brower apparently discusses a corporate mileage bank in which the company and the employee split mileage credits, and a corporate passbook in which the credits accrue solely to the company. (Brower; page 1, lines 29-31). Brower apparently also mentions a corporate identification number used in this context. However, Brower does not discuss or suggest *subtracting miles from boarding information* in any situation. Additionally, the Examiner cites the '359 document as disclosing moving data between accounts. However, the '359 document apparently relates only to a credit card and mileage service, and apparently discusses only the crediting of an account due to a purchase and the inquiry into the account status by the customer. (The '359 document; abstract). There is no reference to *subtracting* in the '359 document.

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Therefore claim 1 is allowable on the basis that none of the cited references disclose the feature of subtracting miles from an account.

Additionally, the Examiner suggests that the combination of the references is obvious "to track the mileages accrued ...." (Office Action; page 13-14). However, no citation to any reference is provided to demonstrate that this motivation is not the result of hindsight reasoning. The Examiner further asserts that the motivation to combine the references is to allow the corporation to obtain the benefit of mileage for business travel, as purportedly discussed in Brower, and to separate the transactions between the employee and the corporation, as purportedly shown in the '962 document. (Office Action; page 6, lines 1-7). However, none of the references provide support for combining the references.

The conclusory statements of the Office Action are insufficient to support a claim of obviousness. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either *explicitly or implicitly in the references themselves or in the knowledge generally available* to one of ordinary skill in the art. (MPEP 2143.01, emphasis added). "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." *In re Kozab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000).

The Federal Circuit addressed the standard for obviousness and the requirement of motivation in *Teleflex, Inc. et al. v. KSR Int'l Co.*, (119 Fed. Appx. 282; 2005 U.S. App. LEXIS 176). The patent at issue in *Teleflex*, related to an electronic pedal position control and a pedal assembly. In *Teleflex*, the district court granted a motion for summary judgment based on

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invalidity due to obviousness. The Federal Circuit vacated the decision and remanded to the lower court for further proceedings on the issue of obviousness. The Federal Circuit stated that, in regard to obviousness, "a person of ordinary skill in the art must not only have had some motivation to combine the prior art teachings, *but some motivation to combine the prior art teachings in the particular manner claimed.*" (*Teleflex*, citing *In re Kotzab*; emphasis added). The Federal Circuit found that that there was no motivation to combine the Asano patent, which disclosed all of the limitations except the electronic control, and the Rixon patent, which disclosed an electronic control and an adjustable pedal assembly. As the court further stated:

[t]he district court correctly noted that the nature of the problem to be solved may, under appropriate circumstances, provide a suggestion or motivation to combine prior art references. However, the *test requires that the nature of the problem to be solved be such that it would have led a person of ordinary skill in the art to combine the prior art teachings in the particular manner claimed.*

(*Teleflex*, citing as background *Rouffier*, 149 F.3d at 1357; emphasis added).

It is respectfully submitted that the present rejection is similar to the rejection discussed in *Teleflex* in that there is no motivation provided in any of Computerage, Brower, the '962 document, or the '359 document to combine its teaching with any of the other references. The Computerage reference apparently discusses mileage credit systems including personal identification cards. However, there is no motivation provided in Computerage to suggest a combination with the corporate mileage bank apparently discussed in Brower. As the *Teleflex* court held, there must be *specific teaching* to motivate a person of ordinary skill in the art must to combine the prior art teachings *in the particular manner claimed*. Therefore, since there is no

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motivation to combine the references, the rejection is improper, and it is therefore requested that the rejection be withdrawn.

Claim 7 recites a similar subtracting feature as recited in claim 1, and therefore claim 7 is allowable for at least the same reasons as claim 1 is allowable.

Claim 2 is allowable based on the lack of motivation to combine the references as discussed above in regard to claim 1. Additionally, claim 2 relates to a system for performing a mileage service depending on a distance traveled by a vehicle covered by the mileage service. The system according to claim 2 includes, *inter alia*, means for determining ***whether miles earned by a usage of the mileage service or the payment of the consideration belong to the corporation or the individual***, based on said selection, and means for storing the earned miles selectively. The Examiner asserts that the feature is disclosed by the combination of the references. However, the Examiner misstates the feature as being merely usage of a mileage service or payment of consideration to use a vehicle. The feature recited however relates to determining whether miles earned by the usage or the payment belong to the corporation or the individual. None of the cited reference discloses, or even suggests, this feature, and therefore, the references, alone or in combination, do not render claim 2 unpatentable.

Claim 3 depends from claim 2 and is therefore allowable for at least the same reasons as claim 2 is allowable.

Claim 5 recites a similar determining feature as recited in claim 2, and therefore claim 5 is allowable for at least the same reasons as claim 2 is allowable.

Claim 8 is allowable based on the lack of motivation to combine the references as discussed above in regard to claim 1. Additionally, claim 8 relates to a method of performing a mileage service depending on a distance traveled by a vehicle covered by the mileage service.

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The method according to claim 8, includes the feature of, *inter alia*, if the vehicle covered by the mileage service is *reserved for the business* of the corporation, *giving earned miles to the corporation*, and if the vehicle covered by the mileage service is *not reserved for the business* of the corporation, *giving earned miles to the employee*. It is respectfully submitted that none of the cited reference discloses, or even suggests, this feature, and therefore, the references, alone or in combination, do not render claim 8 unpatentable.

Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Computerage, Brower, the '962 document, and the '359 document, and further in view of Unexamined Patent No. 2000-132609 (hereinafter referred to as the '609 document). Applicants respectfully traverse.

Claim 6 recites a similar determining feature as recited in claim 2, and therefore claim 6 is allowable for at least the same reasons as claim 2 is allowable.

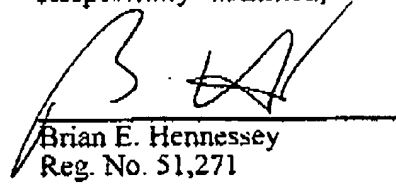
New claim 9 depends from claim 8 and is therefore allowable for at least the same reasons as claim 8 is allowable.

In view of the remarks set forth above, Applicants submit that the application is in condition for allowance. However, if for any reason the Examiner should consider this application not to be in condition for allowance, the Examiner is respectfully requested to telephone the undersigned attorney at the number listed below prior to issuing a further Action.

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Any fee due with this paper may be charged to Deposit Account No. 50-1290.

Respectfully submitted,



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